

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** VICTOR J. YOSHA

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Appeal No. 97-4096  
Application 08/566,008<sup>1</sup>

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ON BRIEF

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Before COHEN, PATE and STAAB, **Administrative Patent Judges.**

PATE, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is an appeal from the final rejection of claims  
1 through 16. These are the only claims in the application.

The claimed invention is directed to a unitary data  
credit card and money holder wherein the user need only carry

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<sup>1</sup> Application for patent filed December 1, 1995.

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one article in the user's pocket that contains both a credit card and money in the clip. The claimed subject matter can be considered in more detail by reference to the appealed claims appended to the appellant's brief.

The references of record relied upon as evidence of obviousness are:

Barnes	4,937,963	July 3,
1990		
Hoyt	5,184,375	Feb.
9, 1993		

#### ***THE REJECTION***

The examiner has rejected claims 1 through 16 under 35 U.S.C. § 103 as unpatentable over Hoyt in view of Barnes. The examiner states the rejection thusly:

Hoyt teaches a clip comprising flat portion 12 having top and bottom edges and top and back surfaces and clip portion 14 (Fig. 2) formed along the top edge and engaging the top surface at tip 34. Clip 14 is attached to the "data portion" 12 at edge 16 to form an integral unit. The device is made from ABS plastic (col. 2, lines 50-52).

Hoyt does not teach a data encoded element in the device, however, this is well known in the art. Barnes teaches a holder including magnetic strip 29 on a flap thereof (col. 2, lines 57-60). It would have been obvious to a person having ordinary skill

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in the art to utilize such a strip on the device of Hoyt to provide machine-readable information which is easily accessible and which will not be misplaced, as is common when cards containing such information must be removed from a holder. (Answer, pages 3-4).

#### **OPINION**

We have carefully reviewed the rejection on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have determined that the applied prior art does not establish a ***prima facie*** case of obviousness with respect to the claimed subject matter. Therefore, the rejection of the claims on appeal is reversed. Our reasons follow.

We are in agreement with the examiner's finding of fact that Hoyt teaches a unitary plastic device with a clip and a flat portion. We are further in agreement with the examiner's finding that Hoyt does not teach a data encoded element. With respect to Barnes, we are in agreement with the examiner that Barnes teaches a magnetic strip which is a data encoded element on

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the inside of flap 29. We are further of the view that the examiner has correctly construed the claim limitation of "data encoded element" to be, for example, a semi-conductor chip or a magnetic strip containing machine-readable data as such is defined on page 2 of appellant's specification. This, however, is the limit of our agreement with respect to the examiner. We are in agreement with the appellant that there is no teaching, incentive, or suggestion for modifying the device of Hoyt to include a data encoded element. It is incumbent upon the examiner to provide a rational basis for the examiner's statement that it would have been obvious to utilize such a data encoded strip on the device of Hoyt. No readily apparent reason or purpose for such a device on the score card carrier of Hoyt comes to mind. In this instance, it is clear that the only incentive for placing the magnetic strip on the score card holder of Hoyt would have been to satisfy the claimed subject matter. Of course, a sustainable rejection cannot be based on such an example of impermissible hindsight.

***REVERSED***

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	IRWIN CHARLES COHEN	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	WILLIAM F. PATE, III	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	LAWRENCE J. STAAB	)	
	Administrative Patent Judge	)	

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